

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Applicants: Michael R.S. Hill et al. Examiner: Frances P. Oropeza

Serial No. 10/039,307 Group Art: 3766

Filing Date: October 26, 2001 Docket No.: P0008969.00

Confirmation No.: 2140

Title: CLOSED LOOP NEUROMODULATION FOR PREVENTION AND  
TREATMENT OF CARDIAC CONDITIONS

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**Pre-Appeal Brief Request for Reconsideration.**

Mail Stop AF  
COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

Please reconsider the rejections set forth in the Final Office Action mailed on 23 June, 2009. A Notice of Appeal is submitted herewith.

Any required fee will be made at the time of submission via EFS-Web. In the event fees are not or cannot be paid at the time of EFS-Web submission, please charge any fees under 37 CFR § 1.16, 1.17, 1.136(a), or any additional fees to Deposit Account 13-2546.

## **Argument**

Claims 17 – 220, 41 – 47 and 54 - 61 are pending. No claims are added. No claims are cancelled. Claims 54 – 61 stand withdrawn due to a constructive election requirement.

It is respectfully asserted that the Final rejection reflects a clear mis-reading of the claims and/or the cited prior art. It is hoped that a careful reconsideration of the issues discussed below will result in withdrawal of the rejections of the claims without the necessity of filing an Appeal Brief.

### **I. Rejections under 35 USC §103**

Claims 17, 18, 20, 41, 42, 46 and 47 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the '428 patent to Obel et al. (Obel) and the '326 patent to Collins (Collins) in view of the '898 patent to Limousin (Limousin). Claim 19 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Obel, Collins and Limousin as applied to Claim 17 and further in view of the '187 patent to Adams (Adams). Claims 43 – 45 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Obel, Collins and Limousin in view of the '277 patent to Sjostrand, et al. (Sjostrand). Applicant respectfully traverses all rejections.

The claims are limited to a device that adjusts electrical nerve stimulation delivered during a delivered cardiac pacing therapy responsive to physiological parameters monitored during the delivery of the cardiac pacing therapy. Obel's device simply does not do this.

The final paragraph of Independent claim 17, for example, requires "means for adjusting the electrical stimulation applied during delivery of the pacing therapy

responsive to the one or more physiological parameters of the patient as monitored during delivery of the pacing therapy" (emphasis added). "The pacing therapy" refers back to the pacing therapy being delivered as set forth previously in the claim, and so both references to it in the final paragraph must be interpreted as referring to delivery of the same pacing therapy. The word "the" could be replaced with the word "said", without changing the meaning of the claims.

Claim 17 thus cannot be properly read as referring to adjustment of parameters after delivery of a prior pacing therapy and prior to "delivery of the pacing therapy", as the device disclosed in the cited Obel reference does. The rejection violates the rules of claim interpretation and is also precisely contrary to the usage of the language in the claim in the specification of the application. As such, the Examiner's interpretation of the claim language cannot be considered to be "reasonable".

If terms in a patent claim are arguably capable of contrary or inconsistent interpretations, they must be given the same interpretation as used in the specification. The law does not require that patent claims use only terms which are not susceptible to arguably different meanings. Most English words have multiple possible meanings, and interpreting the words to have meanings contrary to their usage in the application is not permissible either before or after issuance of the patent.

The nerve stimulation therapies of Obel are delivered according to pre-programmed parameters which are not varied during their delivery, and thus not varied during delivery of the associated cardiac pacing therapy. Correspondingly, the parameters are not varied during previous delivered nerve or pacing therapies either. The nerve stimulation parameters are adjusted only between deliveries of the therapies. As such, Obel functions directly contrary to the limitations of claim 17 and all other claims still pending. .

Because Obel does not include the teaching it is cited for and in fact teaches the contrary, the rejections of the claims over Obel are respectfully asserted to be

clearly erroneous. The cited Collins and Limousin references are not cited as containing this missing teaching and do not in fact contain this missing teaching. Withdrawal of the rejections of claims 17, 18, 20, 41, 42, 46 and 47 is thus respectfully requested.

The cited text in the Abstract of Obel does not contradict the above assertions. The cited text is directed toward initiation of the therapy, which of necessity must occur responsive to parameters sensed prior to initiation of the therapy. As described in detail in the specification, pacing is initiated concurrent with the nerve stimulation therapy in Obel. The cited text thus actually proves the correctness of applicants' assertions.

The Adams and Sjostrand references cited against claims 19 and 43 – 45 are not cited as making up for the deficiencies of Obel as discussed above with regard to claim 17 and in fact do not make up for these deficiencies. Withdrawal of the rejections of claims 19 and 43 – 45 is thus respectfully requested

Accordingly, applicant respectfully asserts that claim 17 as amended and all claims dependant thereon are patentable over the cited references. Withdrawal of the rejection under 35 U.S.C. § 103(a) of all previously submitted claims is respectfully requested.

Because no previously submitted claims have been amended, It is respectfully asserted that any new rejection of the previously submitted claims, including any rejection based on a new interpretation of the Obel, Collins, Limousin, Adams and/or Sjostrand references must take the form of a non-final rejection.

## **Conclusion**

In view of the foregoing, it is submitted that this application is in condition for allowance. Favorable consideration and prompt allowance of the application are respectfully requested.

Should any issues remain outstanding, the Examiner is urged to telephone the undersigned to expedite prosecution. The Commissioner is authorized to charge any deficiencies and credit any overpayments to Deposit Account No. 13-2546.

Respectfully submitted,

Date: September 23, 2009

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